REMARKS

In the Office Action that was mailed on June 29, 2004, claims 1-15, 17-22, 30, and 31 were rejected under 35 U.S.C. § 101 as being non-statutory; claims 1, 2, 5, 11, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Chandra, Adachi, Kay, Larson, McFiggins, Gu, Gabber, Mann, and Evans; claims 3, 4, 19, 25, and 26 were objected to as being dependent upon a rejected base claim; and claim 30 was allowed. The foregoing objections and rejections are respectfully traversed.

Claims 1-31 are pending in the subject application, of which claims 1, 16, 17, 23, 24, 30, and 31 are independent claims.

Amendments to the Claims:

Claims 1, 17, and 31 are amended herein to delete from the preamble "implemented in a computing environment". Claims 1 and 17 are amended herein to recite "receiving a requested account name from a user". Claim 31 is amended herein to recite "receiving a request to generate a unique random account name from a user". Support for such amendments may be found in the Specification, for example, at page 8, lines 13-14. The claims are amended herein to remove 'step(s) of/for' language to make it clear that such claims are not intended to invoke section 112, ¶ 6. The claims are amended herein to recite "at least one" list of word elements. Support for such amendments may be found in the Specification, for example, at page 9, lines 12-15. Claim 17 is amended herein to recite a "preexisting" list of word elements. Support for such amendment may be found in the Specification, for example, at page 9, lines 8-18. Claim 24 is amended herein to recite selecting and combining "if the requested account name is not unique when compared to the list of existing account names." Support for such amendment may be found in the Specification, for example, at page 8, lines 15-18. The claims are amended herein to recite that "at least" the "stem of" the requested account name is combined. Support for such amendments may be found in the Specification, for example, at page 10, lines 1-4. New claims 32-46 are added herein. Support for such new claims may be found in the Specification, for example, at page 8, line 18 to page 9, line 2, at page 9, lines 14-15, at page 10, lines 19-21, and at

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Figures 1-2. New claims 47-51 are added herein, rewriting allowable dependent claims 3, 4, 19, 25, and 26 into independent form. Care has been exercised to avoid the introduction of new matter.

Amendments to the Figures:

Figure 3 is amended herein to relocate a horizontal dot/dash line from below "(RAM)" to above "(RAM)", to correct a drafting error. Support for such amendment may be found in the Specification at page 5, line 16 to page 6, line 2.

Allowable Subject Matter:

The Applicants thank the examiner for indicating that independent claim 30 is allowable.

New independent claims 47-51 are added herein, corresponding to dependent claims 3, 4, 19, 25, and 26 rewritten into independent form (without the amendments to the underlying independent claims presented herein). Dependent claims 3, 4, 19, 25, and 26 are not canceled herein because the underlying independent claims from which they depend are amended herein, thus leaving claims with differing scopes. The Applicants respectfully request that the examiner indicate that new independent claims 47-51 are allowable.

Rejections of the Claims:

Claim 30:

As a preliminary matter, the Applicants note that claim 30 is rejected under § 101 in item 3 on page 2 of the Office Action. However, the Applicants believe that this is a typographical error, because claim 30 is later indicated as being allowed in item 18 on page 19. The Applicants respectfully request clarification, but assert that claim 30 is allowable as indicated and that claim 30 is statutory under § 101 based in part on the reasons discussed below.

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Rejections Under 35 U.S.C. § 101:

The U.S. Patent & Trademark Office's Examination Guidelines for Computer-Related Inventions provide that computer-related process claims, to be statutory, must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. MPEP § 2106(IV)(B)(2)(b). The Guidelines list two safe harbors under (A) above: (1) independent physical acts, and (2) manipulation of data representing physical objects or activities. Id. at § 2106(IV)(B)(2)(b)(i).

Under the second safe harbor provision, a process is statutory if it requires the measurements of physical objects or activities to be transformed outside of the computer into computer data, where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities. Id.

Independent claims 1, 17, and 31 are amended herein to delete from the preamble "implemented in a computing environment". Claims 1 and 17 are amended herein to recite "receiving a requested account name from a user". Claim 31 is amended herein to recite "receiving a request to generate a unique random account name from a user". Claims 2-15 and 18-22 depend, directly or indirectly, from claims 1 or 17. Claims 1-15, 17-22, and 31 (as amended herein) are statutory under the second safe harbor provision discussed above, because they recite the measurement of physical activities (e.g., the user's request) to be transformed into computer data (e.g., input) where the process causes a physical transformation (e.g., providing an account name to the user). The Applicants respectfully request that the examiner withdraw the rejections of claims 1-15, 17-22, and 31 under section 101.

Rejections Under 35 U.S.C. § 103(a):

Differences Between Cited References and Claimed Invention:

Independent Claims 1 and 16:

Chandra discusses maintaining a repository of user information. (Chandra, col. 4, lines 13-32). Chandra also discusses assigning an arbitrary alphanumeric string user identifier to a user. (Chandra, col. 5, lines 35-40). The examiner cites Chandra as disclosing "selecting a word element from a list of word elements." (Office Action, p. 4). However, Chandra does not disclose or suggest maintaining any list of word elements, as recited in independent claims 1 and 16.

Chandra does not disclose or suggest that the creation of an arbitrary alphanumeric string involves anything more than a random character and integer generator. Someone of ordinary skill in the art would not read the maintenance of any word element lists into Chandra. Someone of ordinary skill in the art would read Chandra as discussing only the creation of arbitrary strings, for example, "g3e9T81C" and "4Wmx0uP". In contrast, the Applicants respectfully direct the examiner's attention to page 9, lines 12-15 in the Specification for an example of a list of word elements, as recited in the claimed invention. The Specification gives several examples of "word elements," e.g., adjectives, affixes, nouns, and noun stems. Therefore, a "word element", as recited in the claimed invention, is more than just an arbitrary alphanumeric string.

Therefore, the cited references do not disclose or suggest any "list of word elements," as recited in independent claims 1 and 16 (as amended herein).

Independent Claims 17 and 23:

Gabber discusses a user inputting a "secret" at the beginning of each session, which is used to generate substitute identifiers for the session. (Gabber, col. 7, lines 40-44). Further, in Gabber, "there is no permanent secret information stored on the proxy system." (Gabber, col. 7, lines 46-47). The examiner cites this portion of Gabber as disclosing a list of word elements. (Office Action, p. 11, 13).

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Independent claims 17 and 23 are amended herein to recite at least one "preexisting" list of word elements. Therefore, because the "secret" in Gabber is inputted by the user at the beginning of each session and because the "secrets" are not stored on the system in Gabber, Gabber cannot disclose or suggest at least one "preexisting" list of word elements, as recited in claims 17 and 23 (as amended herein).

Independent Claim 24:

Mann discusses that the user specifies root terms in order to receive a list of available candidate domain names. (Mann, col. 3, lines 43-45). Mann discusses that the user inputs root terms, which are concatenated with adjunct terms to provide a list of candidate domain names. (Mann, col. 4, lines 30-58).

Claim 24 is amended herein to recite selecting and combining "if the requested account name is not unique when compared to the list of existing account names." Mann does not disclose or suggest comparing the user-inputted root names to any list before concatenating the root named with adjunct terms. Mann assumes that the user input is not unique, and generates a suggested domain name accordingly. In contrast, claim 24 of the subject application (as amended herein) selects word elements and combines the word elements with a stem of the requested account name if the requested account name is not unique when compared to the list of existing account names. Clearly, Mann does not disclose or suggest the same.

Independent Claim 31:

The examiner cited Evans as disclosing "providing without any input or suggestion of names from the user, a list of multiple alternate unique account names." (Office Action, p. 18). However, Evans only discusses presenting a user "with a list of possibly hundreds of JCL member names" for testing. (Evans, col. 8, lines 37-40). Evans defines a list of JCL member names as a list of job names that make up a test scenario. (Evans, col. 6, line 66 – col. 7, line 1). Clearly, Evans' list of JCL member names is not even remotely related to a list of multiple

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alternate unique account names, as recited in claim 31.

Lack of Support for Motivation To Combine/Modify Cited References:

MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103,

> there must be some suggestion or motivation, either in the references
> themselves or in the knowledge generally available to one of ordinary
> skill in the art, to modify the reference or to combine reference teachings.
> ... The teaching or suggestion to make the claimed combination and the
> reasonable expectation of success must both be found in the prior art and
> not based on applicant's disclosure.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Office Action has not presented any evidence why Chandra, Gabber, and Mann would have been modified or why Chandra and Adachi or Kay and Evans would have been combined. The mere fact that references <u>can</u> be combined or modified does not render the

resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The sole support in the Office Action for such a combination is that it would yield "the benefit of assigning an account name to a URL to make the unique distinction between separate data access levels and to efficiently ensure the resulting computer generated name is unique" and "an efficient and speedy method of obtaining unique account or file names" and "the benefit of assigning an account name to a registration data set to make the unique distinction between separate data access levels and to efficiently ensure the resulting computer generated name is unique" and "enhance[d] efficiency and effectiveness of the resulting output to ensure an [sic] unique output." Further, the Office Action cannot simply conclude that the motivation to combine two references is "well known." The Office Action cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in any of the references, and the Office Action has not presented any actual evidence in support of the same. Instead, the Office Action relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

The Applicants respectfully call the examiner's attention to the fact that all of the following cases are outdated in light of the cases discussed above: In re Fine, In re Jones, Wang Labs. v. Toshiba Corp., Cable Electric Products v. Genmark, In re Sheckler, In re Bode, In re Jacoby, In re Bozek, and In re Prater. The Applicants note that the examiner's reliance on such older case law would be in error, and the Applicants respectfully request that the examiner review the case law cited by the Applicants above prior to making a determination on the issue.

Lack of Support for Well-Known Conclusions:

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03 (citing In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir.

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2001)). Therefore, the Applicant respectfully traverses the examiner's assertion that the combination of an original id and an arbitrary word and that randomized seeds are created using either single or multiple digit numbers are well known in the art, and requests that the examiner cite a reference in support thereof, present an affidavit supporting the same, or withdraw her reliance upon the same, as required by MPEP § 2144.03 and 37 C.F.R. § 1.104(d)(2).

Conclusion:

Withdrawal of the foregoing objections and rejections is respectfully requested. The remarks herein are to be interpreted only in the context of the specific claims for which they are presented.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-2112.

Respectfully submitted,

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